

REMARKS

Support for claim amendments can be found in the specification, at least in paragraphs [0033]–[0034] and [0071]–[0074]. Reconsideration and further examination are respectfully requested.

§ 112 Rejections

Claims 34–64 were rejected under 35 U.S.C. § 112 as allegedly being indefinite. The Examiner states that claim 34 recite an “apparatus comprising a server performing operating comprising . . . is directed to methods. Thus claim 34 is mixing apparatus and method limitations thus the claim scope is unclear.” See Office Action, page 3. The Applicant respectfully disagrees. Claim 34 does not mention any “method” and only recites steps performed by an apparatus. Therefore, claim 34 is not mixing any method claim with an apparatus claim. Applicant respectfully request the Examiner withdraw the § 112 rejections.

§ 103 Rejections

Claims 1–12, 26, 28, 34–43, 56, 58, 60, 65–70, 71, 73–74 and 76–80, 82–83 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Publication No. 2003/0146939 (Petropoulos). Claims 33, 64 and 75 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Petropoulos. Claims 27, 57, 72 and 81 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Petropoulos as applied to claims 26, 56, 71, or 76 in view of U.S. Publication No. 2003/0224340 (Housman). Claims 13–24 and 44–55 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Petropoulos as applied to claims 1 or 34, and further in view of U.S. Patent No. 7,035,812 (Meisel). Claims 29–32 and 61–63 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Petropoulos in view of Meisel, and further in view of U.S. Publication No. 2003/0135460 (Telagon).

Claim 1 recites “generating, at a server, a morphing advertisement including a compact display format including an associated expansion icon, an expanded display format comprising one or more menu options and a reference to a network location for retrieving specified content

associated with each menu option, and code a client device uses to transition the morphing advertisement from the compact display format into the expanded display format upon a user request to display the expanded display format . . . delivering at one time, from the server to an end user device, the morphing advertisement in response to the request to be presented on the webpage associated with the publisher, the morphing advertisement including the compact display format, the expanded display format, and the code.”

Applicant respectfully asserts the relied upon portions of Petropoulos do not generate any morphing advertisement, much less “generating, at a server, a morphing advertisement **including a compact display format** including an associated expansion icon, an **expanded display format** comprising one or more menu options and a reference to a network location for retrieving specified content associated with each menu option, and **code** a client device uses to transition the morphing advertisement from the compact display format into the expanded display format upon a user request to display the expanded display format.” The relied upon portions of Petropoulos describe allowing a user to see both a search result and a preview but does not disclose any generation of any advertisement on a server.

Furthermore, Applicant respectfully asserts that the relied upon portions of Petropoulos related to a search result and associated preview web page is not the same as Applicant’s claimed morphing advertisement including a **compact** and **expanded** display format as well as **code** that allows the client to transition from a compact display format into an expanded display format, as recited in claim 1. The search result page (nor any individual search result entry) displayed in the Petropoulos system does not include all three of “a compact display format, an expanded display format, and code a client device uses to transition the morphing advertisement from the compact display format into the expanded display format,” as recited in claim 1.

The relied upon portions indicate that a search result is delivered *then* a preview can be prompted. Even if this is construed as being Applicant’s claimed two display formats, which point Applicant does not concede, there is not teaching or suggestion in the relied upon portions that two display formats of an advertisement are delivered as part of a single morphing advertisement (i.e., delivered at one time, not the result of two separate calls). Applicant respectfully asserts that the relied upon portions do not teach or suggest that the two display formats are delivered as part of a single morphing advertisement and include the code that is

used to transition between the two. Rather, as describe in the relied upon portions of the reference, the two different elements are delivered sequentially at two different times (i.e., at a first time the search result is delivered, then at a second time after the user has selected a particular result a preview is delivered). For at least this reason alone, Applicant respectfully asserts that the relied upon portions of Petropoulos do not teach or suggest Applicant's claimed morphing advertisement including the compact and expanded display formats as well as the code that allows the end user system to transition between the two.

The relied upon portions of Housman, Meisel, and Telegon also do not teach or suggest the claimed subject matter missing from Petropoulos namely "generating, at a server, a morphing advertisement including a compact display format including an associated expansion icon, an expanded display format comprising one or more menu options and a reference to a network location for retrieving specified content associated with each menu option, and code a client device uses to transition the morphing advertisement from the compact display format into the expanded display format upon a user request to display the expanded display format . . . delivering at one time, from the server to an end user device, the morphing advertisement in response to the request to be presented on the webpage associated with the publisher, the morphing advertisement including the compact display format, the expanded display format, and the code."

Accordingly, the relied upon portions of Petropoulos, Housman, Meisel, and Telegon taken alone or in combination, do not teach or suggest each and every element of claim 1, and therefore, cannot support a rejection of this claim under 35 U.S.C. § 103(a). Reconsideration and withdrawal of the rejection is respectfully requested and deemed appropriate for at least these reasons. Claims 2-3, 4-24, 26-33 depend from claim 1 and are allowable for at least the same reasons set forth above with respect to claim 1.

Claim 34 recites "generating a morphing advertisement including a compact display format including an associated expansion icon, an expanded display format comprising one or more menu options and a reference to a network location for retrieving specified content associated with each menu option, and code a client device uses to transition the morphing advertisement from the compact display format into the expanded display format upon a user request to display the expanded display format; receiving a request for one or more

advertisements related to a subject matter of interest to be presented on a webpage associated with a publisher; and delivering at one time the morphing advertisement in response to the request to be presented on the webpage associated with the publisher, the morphing advertisement including the compact display format, the expanded display format, and the code.” Claim 34 is allowable for at least the same reasons set forth above with respect to claim 1. Claims 35-58 and 60-64 depend from claim 34 and are allowable for at least the same reasons set forth above with respect to claim 34.

Claim 65 recites “generating at a server, a morphing advertisement including a compact display format including an associated expansion icon, an expanded display format comprising one or more menu options and a reference to a network location for retrieving specified content associated with each menu option, and code an end user system uses to transition the morphing advertisement from the compact display format into the expanded display format upon a user request to display the expanded display format; including the morphing advertisement in an electronic document, the morphing advertisement including the compact display format, the expanded display format, the code, and initially displayed in the electronic document in the compact display format; delivering at one time, from the server to the end user device, the electronic document including the morphing advertisement, wherein the generating, including, and delivering are performed by one or more computers.” Claim 65 is allowable for at least the same reasons set forth above with respect to claim 1. Claims 66-75 depend from claim 65 and are allowable for at least the same reasons set forth above with respect to claim 65.

Claim 76 recites “generating at a server, a morphing advertisement including a compact display format including an associated expansion icon, an expanded display format comprising one or more menu options and a reference to a network location for retrieving specified content associated with each menu option, and code an end user system uses to transition the morphing advertisement from the compact display format into the expanded display format upon a user request to display the expanded display format; including the morphing advertisement in an electronic document, the morphing advertisement including the compact display format, the expanded display format, the code, and initially displayed in the electronic document in the compact display format; delivering at one time, from the server to the end user device, the electronic document including the morphing advertisement, wherein the generating, including,

and delivering are performed by one or more computers.” Claim 76 is allowable for at least the same reasons set forth above with respect to claim 1. Claims 77-83 depend from claim 76 and are allowable for at least the same reasons set forth above with respect to claim 76.

Conclusion

For the foregoing reasons, the Applicant submits that all the claims are in condition for allowance. By responding in the foregoing remarks only to particular positions taken by the Examiner, the Applicant does not acquiesce with other positions that have not been explicitly addressed. In addition, the Applicant's selecting some particular arguments for the patentability of a claim should not be understood as implying that no other reasons for the patentability of that claim exist. Finally, the Applicant's decision to amend or cancel any claim should not be understood as implying that the Applicant agrees with any positions taken by the Examiner with respect to that claim or other claims. Please apply any charges not otherwise paid or any credits to deposit account 06 1050.

Respectfully submitted,

Date: November 13, 2009

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